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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,224	07/27/2001	Wing Foon Lee	509702000100	6824

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EXAMINER

CUNNINGHAM, TERRY D

ART UNIT PAPER NUMBER

2816

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,224

Applicant(s)

LEE ET AL.

Examiner

Terry D. Cunningham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 24 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-14, 18-23, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group A, claims 1-9 and 12-23 (claims 26-28 being generic), in Paper No. 8 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-14 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. The necessary circuitry (e.g. Fig. 5) to provide any of the recited operation is deemed critical or essential to the practice of the invention, but is not included in the claim(s). An arrangement lacking this feature is not enabled by the disclosure since it cannot be understood from the specification how the circuit will operate without such. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 13-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not seen that the specification enables a circuit having no elements to provide the recited operation. This claim would be seen to effectively be a "single means claim", however it is not seen that any elements are recited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5, 9, 13-14, 18-23 and 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the language in line 2 is not understood. It is not understood how a “terminal” or “node” can be “high impedance”. Clearly, a “terminal” or a “node” in and of itself does not have impedance. For there to exist impedance at a “terminal” or “node”, it is required that circuitry be connected thereto, however, nowhere has this been recited. In lines 4-6, similarly as above, it is not understood how the “terminal” or “node” can having “charge injection” and “clock feed-through error voltage” since there has been nothing whatsoever to provide the required “high impedance”.

Claim 5 is rejected for the reasons discussed above with claim 4.

In claim 9, the term “location” is not understood. A circuit is defined by connections, not location, of circuit elements. It is seen that location does have relevance in an integrated circuit. However, an integrated circuit is not being claims.

In claim 12, similarly as with claims 4, it is not understood how the “terminal” can having “charge injection” and “clock feed-through error voltage” since there has been nothing whatsoever to provide the required “high impedance”.

In claims 13-14, it is not understood how the circuit can provide any operation without any recited elements.

Claim 18 is rejected for similar reasons as claim 4.

Claim 19 rejected for the reasons discussed above with claim 18.

In claim 20, line 6, since “a ground or reference voltage” has been recited in line 5, “a” should be changed to --the--.

Claims 21-23 are rejected for the reasons discussed above with claim 20.

In claims 21, 27 and 28, similarly as with claims 4, it is not understood how the “node” can having “charge injection” and “clock feed-through error voltage” since there has been nothing whatsoever to provide the required “high impedance”.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 12-14 and 27-28 are rejected under 35 U.S.C. §102(b) as being anticipated by Hirano et al. (USPN 5, 694,445). Hirano et al. disclose, in Fig. 1, a circuit comprising “a first switching element (ST2)”; “a second switching element (ST1)”; and “a capacitor (CS1)”, all connected and operating similarly as recited by Applicant.

Claims 15-17 and 26 are allowed.

Claims 18-23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry Cunningham whose telephone number is 703-308-4872. The examiner can normally be reached on Monday-Thursday from 7:30 to 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Timothy P. Callahan can be reached on 703-308-4876. The fax phone numbers for Technology Center 2800 are 703-872-9318 for Before Final communications and 703-872-9319

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for After Final communications. Please note, any faxed paper clearly stating **DRAFT** or **PROPOSED AMENDMENT** at the top will be forwarded directly to the Examiner. All others will be treated as a formal response and acted upon accordingly.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0956.

TC
November 26, 2002


Terry D. Cunningham
Primary Examiner
Art Unit 2816